

### **REMARKS**

In the present Office Action, the Examiner has (a) determined that claims 1-37 (as originally filed on October 1, 2003) and claims 62-80 (as presented in the Response to Election Requirement filed on March 21, 2006) are subject to a restriction requirement; and (b) required restriction to one of the following inventions:

Group	claims	drawn to	classified in class	subclass
I	1-10 and 62-73	combination encapsulation machine	425	5
II	16-31	subcombination of the wedge and pump	53	560
III	32-33	subcombination of the capsule conveyor	198	833
IV	34-37	subcombination of the virtual gear	53	52
V	11-18 and 74-80	subcombination of the dies of the capsule forming machine	425	149

Applicants hereby provisionally elect to prosecute the claims of Group I (claims 1-10 and 62-73) in the above-identified case, but traverse the restriction requirement with respect to the claims of Group IV (claims 34-37) and to the amended claims of Group V (claims 11-18 and 74-80).

### **RESTRICTION REQUIREMENT**

With regard to the claims of Groups I and IV and I and V in the present case, the Examiner has stated that the inventions are related as combination and subcombination and inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other

combinations (MPEP § 806.05(c)). Applicants respectfully submit that the restriction requirement in relation to inventions I and IV and I and V is improper as the Examiner has failed to state the subcombination having utility by itself as required.

Regarding inventions I and IV, a showing of the subcombination (Group IV) having utility by itself has not been made. The Office Action states that “the subcombination has separate utility such as moving capsules into a die.” It is respectfully submitted, however, that such separate utility is not present as capsules are not moved into a die. Rather, capsules are formed within the dies as stated throughout the instant application. There is no disclosure of moving capsules into a die in the present application. Thus, Applicants respectfully submit that a showing of the subcombination having utility by itself has not been made. For at least this reason withdrawal of the restriction requirement between inventions I and IV is requested.

Referring now to inventions I and V, Applicants have amended independent claim 11 such that it now is directed to a capsule machine which includes a fill mechanism operable to deliver a fill material. In support of the combination and subcombination assertion, the Office Action states that the subcombination has separate utility such as forming a non-filled compression molded article. However, amended claim 11 now calls for “a fill mechanism operable to deliver a fill material.” Thus, claim 11 is directed toward a filled capsule and does not have the separate utility of forming a non-filled compression molded article. As such, it is respectfully submitted that a separate utility for the invention of Group V relative to the invention of Group I is not present. For at least this reason, withdrawal of the restriction requirement between the inventions of Groups I and V is requested.

Moreover, the restriction requirement between Groups I and IV and between Groups I and V is improper as there will be no serious burden on the Examiner if restriction is not required. As set forth in MPEP §803, restriction may properly be required between patentably distinct inventions if (1) the inventions are independent or distinct as claimed; and (2) there is a serious burden on the Examiner if restriction is not required.

Applicants respectfully submit that there will be no serious burden on the Examiner if restriction between the claims of Groups I, IV, and V is not required because regardless of which set of claims are prosecuted, the fields of search for each invention are so closely related to one another that maintaining them in the same application would not cause undue hardship for the Examiner. A separate field of search is shown to exist only where one of the distinct subjects can be searched in places where no pertinent art to the other subject exists. In this case, however, Applicants submit that when the Examiner is searching for art relevant to the claims of Group I, the Examiner will also encounter references that are pertinent to the examination of the claims of Groups IV and V. In particular, it is noted that claim 36 (Group IV) includes subject matter that is similar to the subject matter of independent claim 1 of Group I. Thus, it is submitted that when the Examiner is searching for subject matter related to claim 1, the Examiner will also find prior art pertinent to the examination of the claims of Group IV. For at least this additional reason, withdrawal of the restriction requirement in relation to Groups I and IV is requested.

Moreover, it is respectfully submitted that when examining prior art relative to the claims of Group I, prior art pertinent to the examination of the claims of Group V will also

class (Class 425). Additionally, it is noted that independent claim 11 has been amended herein to include additional subject matter that is also present in the claims of Group I. Accordingly, when the Examiner is searching for prior art related to the claims of Group I, prior art pertinent to the claims of Group V will also be found. Thus, it is respectfully submitted that an undue burden will not be placed on the Examiner if restriction between the claims of Group I and V is not required. Accordingly, for at least this additional reason withdrawal of the restriction requirement between the claims of Groups I and V is requested.

While Applicants have elected claims 1-10 and 62-73 with traverse for initial examination, Applicants reserve the right to file divisional/continuation applications directed to the subject matter of claims 16-37 and 74-80 in future prosecution.

#### **PETITION DIRECTOR**

If the restriction requirement is maintained and made final, the Applicants preserve the right to petition the Director to review the requirement now or may defer the petition until after final action or allowance of claims to the invention elected (37 C.F.R. § 1.144).

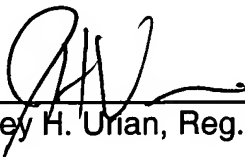
#### **CONCLUSION**

In view of the above, the Applicants respectfully request reconsideration or modification of the requirement of Restriction Requirement. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of

this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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